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1635

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors

: Paul Jarrett et al.

Serial No.

: 09/242,843

Filing Date

: November 18, 1999

Examiner

: S. McGarry

Group Art Unit

: 1635

Title

: PESTICIDAL AGENTS

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Commissioner for Patents  
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Alexandria, VA 22313-1450

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT**  
**UNDER 37 C.F.R. §1.181**

Applicants, by their undersigned attorneys, respectfully request the withdraw of the holding of abandonment of the above-identified patent application and a reinstatement of this application for further consideration by the examiner, pursuant to the exercise of the supervisory authority of the Commissioner of Patents and Trademarks, as provided in 37 C.F.R. §1.181. The holding of abandonment in this case should be withdrawn in view of substantive and procedural improprieties in making the drawing objections in the first instance, as will appear hereinbelow.

**A. STATEMENT OF FACTS**

The present application was filed as a U.S. national stage application under the Patent Cooperation Treaty, pursuant to 35 USC § 371, on November 18, 1999.

Prosecution proceeded in the normal course with a requirement for restriction (dated November 8, 2000), a first Official Action on the merits (dated March 29, 2001) a second non-final Official Action (dated November 20, 2001), a Final Rejection (dated August 12, 2002) and an Advisory Action (dated January 8, 2003), in which applicants' amendment after final rejection was refused entry.

Applicants filed a request for continued examination on February 12, 2003, after which a non-final Official Action was issued May 6, 2003. Enclosed with the May 6, 2003 Official Action was a Notice of Draftperson's Patent Drawing Review (form PTO-948), including certain objections to drawing Figures 1-3. It is noted that the form PTO-948 is dated February 16, 2000, more than three years prior to the Official Action with which it was enclosed. Although check marks appeared in the appropriate boxes under the headings "Application Papers" and "Attachment(s)" in the Official Action summary sheet, there is no mention of the form PTO-948 in the text of the May 6, 2003 Official Action.

On August 1, 2003, applicants, through their

undersigned attorneys, filed what was believed to be a complete response to the May 6, 2003 Official Action. In that response, applicants' representative requested that the requirement for submission of corrected drawings be held in abeyance pending the indication of allowable subject matter.

A Notice of Abandonment was issued January 15, 2004 for the reason that:

"Applicant has requested the drawings requirement be held in abeyance. Effective 11/29/00, a request to hold drawing requirement in abeyance can not be considered a bona fide response. (See 37 CFR 1.185(a) as refereed [sic] to in the PTO-326, box 10, mailed 05/06/03. Applicant time for response has expired."

**B. POINTS TO BE REVIEWED**

1. Absent an indication of specific instances of non-compliance with PCT Rule 11 in the published drawings provided by the International Bureau, the examiner is without authority to required corrected drawings.
2. The drawing objections are improper in any case for failure to comply with established U.S. PTO procedure. If established procedure had been followed, applicants request to hold the drawing corrections in abeyance should have been honored, or else applicants would have submitted corrected drawings in response to a proper notice that failure to do so would result in abandonment of

the application.

**C. REASONS FOR WITHDRAW OF HOLDING OF ABANDONMENT**

1. The Examiner is without authority to require drawing corrections in this case because the same drawings which are alleged to be objectionable were included in the corresponding published PCT application and presumably comply with PCT Rule 11.

The present application was filed as the U.S. National Stage of PCT/GB97/02884, pursuant to 35 USC § 371. Accordingly, the applicants' drawings are required to comply with PCT Rule 11.

In general, the drawings provided by the International Bureau should be acceptable in that they have already been checked and should be in compliance with PCT Rule 11. See § 1893.03(f) of the Manual of Patent Examining Procedure (MPEP). In a case where the drawings were published without meeting all of the requirements of PCT Rule 11, however, the Examiner has the authority to request new or corrected drawings. *Id*

In the present case, the Examiner failed to point out any requirement of PCT Rule 11 that has not been satisfied by the drawings published in the corresponding PCT application.

The present application includes the same three drawing figures that appear in the underlying PCT application. All

of these figures were asserted to be objectionable due to poor line quality. Figures 2 and 3 were further asserted to have numbers and reference characters that are not plain and legible. Figure 2, which is a nucleotide sequence of more than ten (10) pages, was additionally objected to because it is not labeled separately or properly. None of these alleged deficiencies appear in the drawings of the published PCT application. That being the case, these objections are precluded by the following provision fo PCT Article 27:

"No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations."

If the U.S. PTO is unable to reproduce satisfactory copies of published PCT drawings that presumptively comply with the PCT drawing requirements, such inaptitude should not redound to applicants' detriment. Furthermore, it is not understood why the number and reference characters of Figures 2 and 3 could be objected to as not plain and legible when Figure 1 had the same quality of numbers and reference characters and is not considered objectionable. As for Figure 2, although the separate sheets are not separately labeled Figure 2A, Figure 2B, etc., they are consecutively numbered 2/12, 3/12 etc. Thus, these drawings are separately labeled and there is no risk of their winding up out of order in the event they should become separated.

In summary, given that the drawings in this application

were included in the corresponding published PCT application, and therefore, presumptively comply with the requirements of PCT Rule 11, the Examiner is without authority to require corrected drawings in the present case.

2. The drawing objections in this case do not comply with established U.S. PTO procedure and are, therefore, improper.

The subject of informal drawings is addressed in § 608.02(b) of the MPEP, which provides in pertinent part:

"The Examiners are directed to advise the applicants by way of form PTO-948 (see MPEP § 707.07(a)) in the first Office Action of the reasons why the drawings are considered to be informal [emphasis added]."

The form paragraphs (§§ 6.21 and 6.22) recommended for notifying applicants of drawing defects both include express warnings to the effect that submission of corrected drawings is required to avoid abandonment of the application and that the objection to the drawings will not be held in abeyance.

Similarly, § 707.07(a) of the MPEP provides:

"Forms are placed in informal applications listing informalities noted by the Draftsperson (form PTO-948)....Each of these forms comprises an original for the file record and a copy to be mailed to applicant as part of the Examiner's first Action. They are specifically referred to as attachments to the Action and are marked with its paper number. In every instance where these forms are to be used, they should be mailed with the Examiner's first Action.... [emphasis in original]."

In the present case, the drawing objection was not raised in the first Action, but in the sixth Action, after

filling a request for continued examination. Nor was the recommended form paragraph used to notify applicants of the asserted drawing informalities when the drawing objections were ultimately raised. There is no apparent reason why, contrary to the clearly expressed guidelines of the MPEP, the drawing objection was not made in the first Action. As noted above, the form PTO-948 was completed on February 16, 2000 and presumably was available for inclusion with the restriction requirement dated November 8, 2000.

Rather than include one of the recommended form paragraphs mentioned above in the body of the May 6, 2003 Official Action, the Examiner referred applicants, in the Notice of Abandonment, to box 10 of the May 6, 2003 Official Action. A review of box 10 of the Office Action Summary reveals, however, that it is only partially completed. The line provided for the date of submission of the drawings is left blank, and the two (2) separate boxes marked with an "X" are easily overlooked. On the other hand, the reverse side of the form PTO-948 specifically states, under the heading "Correction of Informalities--37 C.F.R. 1.85", "Applicant may delay filing of the new drawings until receipt of the Notice of Allowability (PTOL-37)". Thus, the Examiner's reference to box 10 of the Office Action Summary of the May 6, 2003 Official Action does not tell the entire story, as there are conflicting directions provided in the form PTO-948 as to how applicants may go about complying

with the requirement for corrected drawings.

If the above-mentioned guidelines, of MPEP §§ 608.02(b) and 707.07(a) had been followed in this case, applicants' request to hold the requirement for corrected drawings in abeyance would have been permissible. The version of PTO Rule 85 in effect on November 8, 2000 contained no provision that such a request would not be considered a bona fide response.

On the other hand, if the May 6, 2003 Official Action had included the recommended form paragraph calling to applicants' attention that corrected drawings are required in response to the Official Action to avoid abandonment, then corrected drawings would have been submitted. As it is, the May 6, 2003 Official Action contained no clear notice that the application would be held abandoned if applicants failed to submit corrected drawings with their reply. On the contrary, the form PTO-948 clearly stated that the drawing corrections could be held in abeyance pending receipt of the Notice of Allowability.

**D. THE DRAWING CORRECTIONS COULD HAVE BEEN HANDLED INFORMALLY IN ORDER TO AVOID ABANDONMENT**

The requirement that business with the PTO be conducted with courtesy (37CFR § 1.3) should apply both ways. Applicants' reply to the May 6, 2003 Official Action was filed prior to the three month shortened statutory response period. The Examiner, as a matter of courtesy, could have

telephoned applicants' representative to apprise him that the response was deficient and that the application would be held abandoned if the corrected drawings were not submitted during the remainder of the response period. The extension of such a courtesy would have been particularly appropriate in this case, considering the age of the Draftperson's objection on which the holding of abandonment is based.

**E. CONCLUSION**

In view of the facts and circumstances described above, it is respectfully requested that this petition be granted and the application be reinstated and returned to the Examiner for further prosecution.

It is believed by the undersigned attorney that no fee is required under 37 C.F.R. § 1.181 FOR the present petition, which is being filed within two months of the mailing date of the notice from which relief is requested. In the event that a fee is required, however, the Commissioner is authorized to charge the deposit account of the undersigned attorney's, Deposit Account No. 04-1406.

Respectfully submitted,  
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Dated: 20 February 2004

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Attorneys For Applicants  
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# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Patent Application of:

Examiner: S. McGarry

Paul Jarrett et al.

Group Art Unit: 1635

Application No. 09/242,843

Atty Docket No.: 0380-P01838US0

Filed: 11/18/99

Title: "PESTICIDAL AGENTS"

## CERTIFICATE OF MAILING UNDER 37 CFR § 1.8(a)

I hereby certify that this correspondence is being deposited on February 20, 2004 with the United States Postal Service as first-class mail in an envelope properly addressed to the COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450.

Dawn M. Holzwarth  
Typed Name of Person Mailing Paper

Dawn M. Holzwarth  
Signature of Person Transmitting Paper

### Computation of Additional Fee for Petition

No Additional Fee is required.  
 The Commissioner is authorized to charge any required fee to the deposit account of the undersigned attorneys, **Deposit Account No. 04-1406**. A duplicate copy of this sheet is enclosed.

The fee has been calculated as shown below:

CLAIMS AS AMENDED				*SMALL ENTITY		OTHER THAN A SMALL ENTITY	
FOR	CLAIMS AFTER AMDT.	CLAIMS PAID FOR	NUMBER EXTRA	RATE	FEE	RATE	FEE
EFFECTIVE TOTAL CLAIMS			0	\$ 9		\$ 18	
IND. CLAIMS			0	43		86	
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIMS?				145		290	
PETITION FEE FOR EXTENSION				TOTAL		\$	

DANN, DORFMAN, HERRELL AND SKILLMAN  
A Professional Corporation

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